

Neifeld Docket No: CAT29US-SCRCO3

Application/Patent No: 09/756,788

USPTO CONFIRMATION NO: 6599

File/Issue Date: January 10, 2001

Inventor/Title: MICHAEL C. SCROGGIE ET AL./System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: JANVIER/3688

ENTITY STATUS: LARGE

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

**1. THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES
WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT
ACCOUNT NUMBER 50-2106.**

2. FEES PAID HERewith BY EFS CREDIT CARD SUBMISSION: \$420

A. CLAIMS FEES

0.00 \$ - (claims previously paid for; currently present; \$50 per addl. claim over 20.)

0.00 \$ - (independent previously paid for; currently present; \$200 per addl. claim over 3)

B. OTHER FEE \$

3. THE FOLLOWING DOCUMENTS ARE SUBMITTED HERewith:

RESPONSE TO 1/26/2009 NOTIFICATION OF NON COMPLIANT APPEAL BRIEF

4. FOR INTERNAL NEIFELD IP LAW, PC USE ONLY

USPTO CHARGES: \$ CLIENT BILLING MATTER: CAT29USSCRO BANK ACCOUNT/Check: 3/ G/L ACCOUNT:	FIRM CHARGES: \$ DESCRIPTION: FIRM CHARGE FOR paying the increased gov. fee. for NOA and appeal LAWYER: ran
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INITIALS OF PERSON WHO **ENTERED** ACCOUNTING DATA: ran

ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT)

DATE: 1-27-2009

SIGNATURE: /RichardNeifeld#35,299/

Richard Neifeld, Reg. No. 35,299

Printed: January 30, 2009 (3:10pm)

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RESPONSE TO
NOTIFICATION OF NON COMPLIANT APPEAL BRIEF DATED 1/26/2009

I. PROVISIONAL RESPONSE, WITH TRAVERSE

The applicant traverses the requirement in the 1/26/2009 Notification of Non Compliant Appeal Brief as improper and requests reconsideration and withdrawal of the notification.

The applicant also responds to the requirement in the notice in order to avoid an improper abandonment of the application due to failure to respond to the improper requirements in the Notification. The Notification states that:

This Application is not in condition for Appeal. Indeed, the filing of an Appeal Brief in the Instant Application is premature. On 09/17/08, the Office mailed a Non-Final Action to the Applicant. On 09/29/08, the Applicant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim amendment and arguments. Even before, the Examiner issues a response to the 1.111 reply, Applicant filed on 10/23/08 a Notice of Appeal together with an Appeal Brief. Here, the Applicant can either render the 1.111 reply null and void to thereby proceed with the Appeal Brief after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered by the Examiner.

With traverse, the applicant "render the 1.111 reply null and void to thereby proceed with the Appeal Brief after updating the said Appeal or withdraw the Appeal". The office action dated 9/17/2008 was in response to the communication of "17 October 2006". Office action item 1. The communication the applicant filed 17 October 2006 consisted of the following two papers:

- (1) RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
- (2) 37 CFR 41.37 FOURTH SUPPLEMENTAL APPEAL BRIEF

The applicant elects to proceed with the appeal brief filed 17 October 2006, without updating the appeal brief. The applicant believes that action will most promptly result in decision on the petition filed 1/30/2009 thereby expediting a decision on the merits of the application.

II. STATEMENT OF MATERIAL FACTS IN SUPPORT OF WHY THE NOTIFICATION IS IMPROPER

1 On 1/21/2003, the office mailed an office action, which examined and rejected claims 32-58.

2 On 5/21/2003, the office mailed an office action, which examined and rejected claims 32-58.

3 On 9/17/2003, the office mailed an office action naming, which examined and rejected claims 32-58.

- 4 On 3/14/2004, the applicant filed an appeal.
- 5 On 5/4/2004, the office mailed an office action, and examining claims 32-91.
- 6 On 10/17/2006, the applicant filed a response to the 9/21/2006 notice, traversing the requirements in the notice, and filing a paper titled "Fourth Supplemental Appeal Brief".
- 7 On 9/17/2008, the office mailed a paper, reopening prosecution, examining claims 32-91, and rejecting those claims.
- 8 On 9/28/2008, the applicant an amendment and evidence in support thereof.
- 9 On 10/23/2008, the applicant reinstated the appeal, filing a new notice of appeal and appeal brief.
- 10 On 1/27/2009 Notice of Non Compliant Appeal Brief states that:

This Application is not in condition for Appeal. Indeed, the filing of an Appeal Brief in the Instant Application is premature. On 09/17/08, the Office mailed a Non-Final Action to the Applicant. On 09/29/08, the Applicant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim amendment and arguments. Even before, the Examiner issues a response to the 1.111 reply, Applicant filed on 10/23/08 a Notice of Appeal together with an Appeal Brief. Here, the Applicant can either render the 1.111 reply null and void to thereby proceed with the Appeal Brief after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered by the Examiner.

- 11 35 USC 132(a) states that:

35 U.S.C. 132 Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention. [Underlining added for emphasis.]

- 12 35 USC 134(a) states that:

35 U.S.C. 134 Appeal to the Board of Patent Appeals and Interferences.

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal. [Underlining added for emphasis.]

13 Ex parte Lemoine states in relevant part that:

To reach a decision requires to construe the word "claims" as used in § 134. The word is susceptible to at least two interpretations. It can refer to the claims of an application, i.e., the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S.C. § 112, ¶2. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent. Section 134 merely uses the word "claims." We must, therefore, decide which construction to give to the statute. We conclude that "claims" in § 134 should be construed consistently with its use in § 132 to mean "claims for a patent" rather than particular "claims of an application."

Section 134 is part of Chapter 12 of Title 35. Chapter 12 is titled "Examination of Application" and sets forth the general procedures to be followed in the Office for examination. Sections 131 to 134 provide the general procedures relating to ex parte examination. In relevant part, these sections specify that (1) an examination shall be made (§ 131); (2) if "any claim for a patent" is rejected, the applicant shall be informed of the bases of the rejection (§ 132); (3) if the applicant persists in the "claim for a patent, with or without amendment," the application shall be reexamined (§ 132); and (4) if applicant's claims have been twice rejected, the applicant may appeal (§ 134). Considering these sections together, we conclude that the "claims" as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132 rather than a reference to a particular claim "of an application." Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed. So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction. [Ex parte Lemoine, 46 USPQ2d 1420, ____ (PTOBPAI 1994)(precedential decision of a BPAI expanded panel, 12/27/1994). Underlining and italics added for emphasis.]

14 37 CFR 41.37(a) specifies the rule depending from 34 USC 134(a), stating that:

§ 41.31 Appeal to Board.

(a) Who may appeal and how to file an appeal. (1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply. [Underlining added for emphasis.]

15 37 CFR 41.31 was promulgated in the Final Rule published 8/14/2004, at 69 FR 49960.

16 Comment 36 in the Final Rule published 8/14/2004 states that:

Comment 36: One comment suggests that §§ 41.31(a)(1), (a)(2) and (a)(3) be amended to provide for appeal at any time after being twice or finally rejected, as appropriate, during pendency of the proceeding where no time period under § 1.134 is running. The comment states that the suggested change would ensure that § 41.31 would not be interpreted more restrictively than 35 U.S.C. 134, which sets forth no condition regarding when an appeal can be filed, apart from the requirements for claims being twice rejected (as in 35 U.S.C. 134(a)) or finally rejected (as in 35 U.S.C. 134(b) and (c)). *The comment also states that this amendment would prevent any potential inconsistency of the rules with the Board's precedential opinion, Ex parte Lemoine, 46 USPQ2d 1420, 1423 (BPAI 1994).*

Answer: The suggestion will not be adopted. Sections 41.31(a)(1), (a)(2) and (a)(3) were proposed to generally incorporate the requirements of former § 1.191(a) (2003) and to subdivide § 1.191(a) into three parts to improve readability. Both former § 1.191(a) (2003) and §§ 41.31(a)(1), (a)(2) and (a)(3) are more restrictive than 35 U.S.C. 134 in that an appeal must be filed within the time period provided under § 1.134 for response to either a final rejection or a non-final rejection which rejects the claims for a second time, as appropriate. For example, an applicant for a patent whose claims have been twice rejected but not finally rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134. However, if such an applicant files an amendment within the time period provided under § 1.134, the applicant may not file an appeal ***outside the time period provided under § 1.134***. In such a situation, the applicant must wait for a new rejection by the examiner before an appeal can be filed. [69 FR 49974 right hand column; bold and italics added for emphasis.]

III. REASONS WHY THE NOTICE SHOULD BE WITHDRAWN AND THE

APPEAL FILED 1023/2008 SHOULD BE REINSTATED

The appeal brief filed 10/23/2008 was after applicant's claim for a patent had been twice or more rejected. Facts 1-19. As clearly explained in Ex parte Lemoine, 35 USC 134(a) specifies that an applicant has the right to appeal any time their application has been twice or more rejected, which is the case here. Facts 27-29. As in Lemoine, the existence of amended claims is not relevant to the right to appeal. Accord: Appeal Nos: 20074469; 20061027, available from the BPAI web site of final decisions.

Moreover, the appeal brief filed 10/23/2008 was "within the time period provided under § 1.134" as required by 41.31(a). Facts 19-21. Therefore, as clearly stated in comment 36, the appeal was not "*outside the time period provided under § 1.134*". Fact 32.

Fact 32, comment 36 on rule 41.31 states that "However, if such an applicant files an amendment within the time period provided under § 1.134, the applicant may not file an appeal *outside the time period provided under § 1.134*". This example clearly an unequivocally means that, if the applicant does file an amendment and an appeal, and both are within the time for responding to the office action, then the appeal is proper. Accordingly, the appeal is proper and the Notice is improper. Therefore, the applicant had the right under rule 41.31, 35 USC 134(a), and Ex parte Lemoine, to file the appeal.

Moreover, the ultimatum in the Notice is unprecedented, and the examiner identified no authority in support of the right to make such an ultimatum. This indicates a disregard for authority, and a disregard for the propriety of the action.

Furthermore, the examiner has the right under the rules now in force to reply in an answer with a new ground of rejection to address amended claims. 37 CFR 41.39(a)(1), added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004 (noting that rules intended to go into for 12/2008 were indefinitely suspended and are not in force.) Accordingly, there is no policy reason for the examiner to be allowed to violate the rules to force the applicant to withdraw the appeal or amendment.

Still further, leaving the most recent improper Notice undisturbed detracts from applicants substantive rights by further delaying the date this application will issue as a patent.

Finally, given that patent term adjustment depends upon duration of appeal, and upon delays due to the filing of correcting papers. Therefore, the examiner's requirement will affect the applicants substantive right to duration of patent term once this application issues.

For all of the foregoing reasons, the Notice should be withdrawn and the appeal filed 10/23/2008 considered.

1-30-2009

DATE:

/RichardNeifeld#35,299/

SIGNATURE:

Richard Neifeld, Reg. No. 35,299

Attorney of record

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January 30, 2009 (3:10pm)

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